



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,853	11/19/2003	Po W. Yuen	7323	5614

39196 7590 08/25/2005

SHLESINGER, ARKWRIGHT & GARVEY LLP
1420 KING STREET
SUITE 600
ALEXANDRIA, VA 22314

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,853

Applicant(s)

YUEN, PO W.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 6 and 9 have been amended for further examination. Claims 1-5, and 11-15 have been canceled. Claims 16-19 have been added.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 6-10 and 16-19 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 16 recites the limitations: "said front surface central" in line 12; and said front surface right top rectangular section and said back surface left top rectangular section forming a pair of unattached connected outside edges and a pair of attached connected inside perforated edges" as stated in lines 17-20. It is not clear how the "front surface right top rectangular section forms a pair attached connected inside perforated edges". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 7 and 16-19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al (6,623,039) in view of Long (6,572,149).

Thompson et al discloses in Fig. 1-3, a postal mailer comprising: a post card (10) having a panel having front surface (10a), back surface (10b), wherein each have a left top (A), a right top (B), a left bottom (C) and a right bottom (D) and central sections (E); wherein the post card having calling card stiffness; wherein the front surface right top (B) section including a postage positioning area (12), left top section being rectangular having indicia (Col. 7, lines 5-8, wherein "information about the card" is capable of being information about the addressor); the front surface central section, left bottom and right bottom sections including forwarding address information (wherein area (14) can be written on any section on the front surface; back surface right top section being rectangular and coextensive and cooperating with the front surface left top section to form a removable card (16); wherein the front surface right top rectangular section (B) and said back surface left top rectangular section (B2) forming a pair of unattached connected outside edges (L1 and L2), and a pair of attached connected inside perforated edges (L3 and L4), which when broken forms the removable card (16); wherein the back surface left top, left bottom, right bottom and central sections have indicia (Col. 5, lines 27-29), wherein the removable card (16 having separate coupon indicia) being spaced from the back surface indicia (when detached); and wherein the postal mailer is a bi-fold which includes a second panel (see Fig. 27) having corresponding dimensions which overlap the first panel.

However, Thompson et al does not disclose wherein the back surface has a locator map having information including addressor, landmarks and street indicia observable from all other map location; wherein the observable addressor location and landmarks are of a different color from the street indicia; and wherein the back surface includes a second language.

Long discloses in Fig. 1-4, a postal mailer comprising: a post card (10) having front (see Fig. 2) and back surfaces (see Fig. 1), wherein back surface (see Fig. 1) having map indicia (M);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson et al's postal assembly with a locator map having map indicia, which includes landmarks, references and colors as taught by Long for providing directions and locations of the subscribing company or organization.

In regards to **Claims 17-19**, it also would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable indicia on the postal mailer, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the front and back surface sections and panels, since applicant has not disclosed the criticality of a particular area on the postal mailer having certain indicia, and invention would operate equally as well with indicia placed on any given surface or section.

Allowable Subject Matter

4. Claims 8-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Unger, Warther et al, Richardson, and Kim disclose similar postal mailers.

Response to Arguments

5. Applicant's arguments with respect to claims 6-10 and 16-19 have been considered but are moot in view of the new ground(s) of rejection.

Thompson et al discloses in Fig. 1-3, a postal mailer comprising a removable card wherein the indicia on the front and back surfaces of the card can be switched, wherein front surface of the removable card can have information pertaining to company's name and location

(as stated in Col. 5, lines 14-17, and Col. 7, lines 5-7). Long is now used to disclose a postal mailer wherein the front surface of the card has indicia at particular sections, and a locator map on its rear surface. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson et al's postal assembly with a locator map having map indicia, which includes landmarks, references and colors as taught by Long for providing directions and locations of the subscribing company or organization.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3722

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

August 21, 2005

BOYER -
PRIMARY EXAMINER



BOYER D. ASHLEY
PRIMARY EXAMINER